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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,325	12/31/2001	Saori Kitao	04276.00003	2310

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EXAMINER

YAEN, CHRISTOPHER H

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/889,325

**Applicant(s)**

KITAO ET AL.

**Examiner**

Christopher H Yaen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 8-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

**RE: Kitao *et al***  
**Priority Date: 19 January 1999**

#### ***Election/Restrictions***

1. Applicant's election of group III in the reply filed on 6/29/2004 is acknowledged. Because applicant did not specifically state that the election was made with traverse, the election has been treated as an election without traverse.
2. Claims 1-14 are pending, claims 1-6 and 8-14 are withdrawn from further consideration as being drawn to non-elected inventions.
3. Claim 7 is therefore examined on the merits.

#### ***Information Disclosure Statement***

4. The Information Disclosure Statements filed 7/13/2001, 1/22/2002 and 4/5/2002 are acknowledged and considered. A signed copy of the IDS is attached hereto.

#### ***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. In particular, claim 7 is rejected as vague and indefinite for reciting the term RecQ4 as the sole means of identifying the claimed molecule. The use of laboratory designations only to identify a particular molecule renders the claims indefinite because

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different laboratories may use the same laboratory designations to define completely distinct molecules. Amending the claims to specifically and uniquely identify RecQ4 by a sequence identifier and function may obviate the rejection.

7. Claim 7 is further vague and indefinite because it is not clear as to what the “agent” contains, does the agent contain just the antibody or is it an antibody binding to helicase? For the purposes of comparing the claims to the prior art, it will be assumed that the diagnostic agent contains only the antibody.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The written description in this case has only set for an antibody that is capable of binding to a RecQ4 helicase of SEQ ID No: 4 and therefore the written description in this case is not commensurate in scope to the claim that reads on any and all antibodies that bind to RecQ4 helicases.

*Vas-Cath Inc. V. Mahurkar*, 19 USPQ2d 1111, clearly states that “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought,

he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117). The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See *Vas-Cath* at page 1116). Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 USC 112 is severable from its enablement provision (see page 115).

The claim recites an antibody that binds to "RecQ4" as part of the invention. However, there does not appear to be an adequate written description in the specification as-filed of the essential structural feature of the broad genus of RecQ4 proteins claimed. The Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement make clear that the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the genus (Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001, see especially page 1106 3<sup>rd</sup> column).

Applicant does not appear to have reduced to practice all RecQ4 proteins claimed. Neither has Applicant provided a sufficient written description of any structure that may be correlated with the function of RecQ4. A "RecQ4" encompasses *any*

molecule with the helicase activity. Thus the genus of compounds encompassed by this term is extensive and the artisan would not be able to recognize that Applicant was in possession of the invention as now claimed. In addition, as noted supra "RecQ4" is an indefinite term and therefore the structure of a "RecQ4" which an antibody is to recognize is also not described. It is further noted that because the helicases have multiple members of an emerging family, it is not possible for the office to determine whether the RecQ4 helicase claimed is the same or different from those already present in the prior art.

Consequently, Applicant was not in possession of the instant claimed invention. See Regents of the University of California v. Eli Lilly and Co. 119 F.3d 1559, 43 USPQ2d 1398 (Fed. Cir. 1997). Adequate written description of genetic material "requires a precise definition, such as by structure, formula, chemical name, or physical properties,' not a mere wish or plan for obtaining the claimed chemical invention." Id. 43 USPQ2d at 1404 (quoting Fiers, 984 F.2d at 1171, 25 USPQ2d at 1606). The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter of the claim. Id. 43 USPQ2d at 1406. A description of what the genetic material does, rather than of what it is, does not suffice. Id.

Applicant is directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001. Applicant is invited to point to clear support or specific examples of the claimed invention in the specification as-filed.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,472,513.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention are drawn to a diagnostic agent comprising as its effective ingredient an antibody that binds to the RecQ4 helicase. It is also noted that US Patent No. 6,472,513 also encompasses RecQ4 helicase because SEQ ID No: 2 is defined as RecQ4 helicase. One of ordinary skill in the art would have found it *prima facie* obvious to make a RecQ4 diagnostic agent with an antibody against RecQ4 as the effective ingredient because US Patent 6,472,513 has already claimed such an antibody. The use of the instant invention as a diagnostic agent is an intended use and does not breadth any patentable weight into the claims nor does provide any distinguishing characteristics over the prior US patent.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Puranam *et al* (J. Biol Chem. November 1994; 269(47):29838-29845). Because the RecQ4 protein in which the antibody of the instant invention binds has not been identified by a specific sequence identifier and because the office does not have the facilities to determine whether the RecQ4 protein of the instant invention is distinguishable from that found in the prior art, for the purposes of this rejection, the RecQL protein is RecQ4. Puranam *et al* teach an antibody that binds to RecQ4, (see abstract and page 29839). The diagnostic uses of the antibody is an intended usage and does not breathe any patentable weight into the claims.

***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 571-272-0838. The examiner can normally be reached on Monday-Friday 9-5.

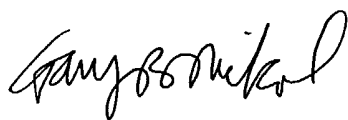


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Yaen  
Art Unit 1642  
August 12, 2004

A handwritten signature in black ink, appearing to read "Gary Nickol", written in a cursive style.

**GARY NICKOL**  
**PRIMARY EXAMINER**